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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,169

01/27/2006

Kimitaka Sato

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CLARK & BRODY

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WASHINGTON, DC 20005

EXAMINER

SHEEHAN, JOHN P

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

09/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,169	Applicant(s) SATO, KIMITAKA	
	Examiner John P. Sheehan	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/27/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

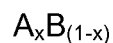
Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 to 3, 6, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daimon et al. (Daimon '336, U.S. Patent Application Publication No. 2004/0074336, cited by the Examiner).

Daimon '336 teaches magnetic alloy particles having the composition



where $40 \leq x \leq 60$, A is selected from the group consisting of Fe and Co and B is selected from the group consisting of Pt and Pd (paragraphs [0035] and [0036]). This alloy composition taught Daimon '336 is encompassed by the alloy composition recited in the instant claims. Daimon '336 teaches that the alloy particles have the face-

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centered tetragonal structure as recited in the instant claims (paragraphs [0008] and [0033]). Daimon '336 teaches that the particles have a particle size of 1 to 50 nm which encompasses applicant's claimed particle size of 5 to 30 nm (paragraph [042]). Daimon '336 teaches that the alloy particle can additionally contain Ag as recited in claim 7 (paragraph [0061]). Daimon '336 teaches that the particles are dispersed from each other as recited in claims 1, 2 and 3 (paragraph [0062]). Daimon '336 teaches that the particles have a coercivity of 5400 to 6500 Oe which is encompassed by the coercivity of 1000 Oe or greater recited in claim 6 (paragraph [0173], the last sentence). Daimon '336 teaches a process of making the alloy particles that is substantially the same as applicant's disclosed method of making the applicant's claimed powder (compare Daimon '336, paragraphs [0050]-[0054] to the instant specification page 20, the first full paragraph).

The claims and Daimon '336 differ in that Daimon '336 is silent with respect to the remaining properties recited in the claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy powder composition taught by Daimon '336 is encompassed by the alloy powder composition recited in the instant claims and Daimon '336's powder is disclosed as possessing some of the properties recited in the instant claims and is made by a process which is substantially the same as applicant's disclosed process of making the instantly claimed alloy powder. In view of this, Daimon '336's alloy powder would be expected to posses

all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977).” see MPEP 2112.01.

4. Claims 4 and 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Daimon '336 as applied to claims 1 to 3, 6, 7 and 9 above, and further in view of Kanekiyo et al. (Kanekiyo '235, U.S. Patent Application No. 2002/0117235, cited by the Examiner).

Daimon '336 teaches and is applied as set forth above.

Kanekiyo '235 teaches adding a coupling agent such as titanate or aluminate or a surfactant such as zinc stearate to a magnetic powder so as to improve the properties of the magnetic powder (paragraph [0258]).

The claims and Daimon '336 differ in that Daimon '336 does not teach the addition of a surfactant or coupling agent to the magnetic powder.

However one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because one of ordinary skill in the art would have been motivated to add a coupling agent and/or a surfactant to Daimon

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'336's magnetic powder so as to improve the properties of the magnetic powder as taught by Kanekiyo '235.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daimon '336 as applied to claims 1 to 3, 6, 7, and 9 above, and further in view of Aoyama et al. (Aoyama '930, U.S. Patent No. 6,666,930, cited by the Examiner).

Daimon '336 teaches and is applied as set forth above in the rejection of claims 1 to 3, 6 7 and 9.

Aoyama '930 teaches that the addition of Group Iva, Va, IIb and IVb elements to a Pt-Fe alloy improves the magnetic properties of the alloy (column 4, lines 51 to 59).

The claims and Daimon '336 differ in that Daimon '336 is silent with respect to the additional elements recited in applicant's claim 8.

However one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because one of ordinary skill in the art would have been motivated to add a Group Iva, Va, IIb and IVb element to instantly claimed alloy powder so as to improve the magnetic properties of the alloy powder as taught by Aoyama '930.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 to 11 of copending Application No. 10/812,078. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of these two sets of claims overlap and therefore there is considered to be a prima facie case of obviousness. Further, in view of the fact that the instantly claimed alloy powder composition and that of 10/812,078 are the same it would be expected that the two powders would have the same properties as recited in the instant claims, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not

necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 to 9 are directed to an invention not patentably distinct from claims 1 to 11 of commonly assigned application 10/812,078. Specifically, although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of these two sets of claims overlap and therefore there is considered to be a prima facie case of obviousness. Further, in view of the fact that the instantly claimed alloy powder composition and that of 10/812,078 are the same it would be expected that the two powders would have the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/812,078, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly

assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

7. Claims 1 to 9 are rejected under 35 U.S.C. 103(a) as being obvious over 10/812,078.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and

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reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Claims 1 to 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 to 10 of U.S. Patent No. 7,390,576. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of these two sets of claims overlap and therefore there is considered to be a prima facie case of obviousness. Further, in view of the fact that the instantly claimed alloy powder composition and that of 10/812,078 are the same it would be expected that the two powders would have the same properties as recited in the instant claims, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).” see MPEP 2112.01.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/
Primary Examiner
Art Unit 1793

JPS